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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,061	05/22/2001	David D. Goodman	03133-005017	8001

7590 04/28/2003

Hale and Dorr, LLP
1455 Pennsylvania Avenue, NW
Washington, DC 20004

EXAMINER

CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 04/28/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

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B

Office Action Summary

Application No.
09/863,061

Applicant(s)
Goodman

Examiner
Wing Fu Chan

Art Unit
2643



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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1. The present application Serial No. 09/863,061 is a continuation of application Serial No. 09/292,895 filed 4/16/99 now US PAT. 6,236,718 which is a continuation of Serial No. 08/819,120 filed 3/17/97 now US PAT. 5,949,473 which is a R60 continuation of Serial No. 08/431,270 filed 4/28/95 (abandoned) which is a R60 continuation of Serial No. 08/181,562 filed 1/13/94 (abandoned) which is a R60 continuation of Serial No. 08/062,148 filed 5/14/93 (abandoned) which is a FWC of Serial No. 07/688,864 filed 4/19/91 (abandoned) which is a continuation of Serial No. 07/379,751, now US PAT. 5,010,399.

2. The action is in response to the RCE filed 4/2/03 and as directed by the amendment filed 10/2/02, claims 32 was canceled, new claims 33-58 were added. Therefore, in the present application claims 33-58 are pending.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 for example.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 for example.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 for example.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 for example.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 for example.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 33-58 are rejected under the judicially created doctrine of double patenting over claims 1-9 of US PAT. 6,542,585, claims 1-6 of US PAT. 6,236,718, claims 1-63 of US PAT. 6,236,718, claims 1-3 of US PAT. 6,185,284, claims 1-5 of US PAT. 6,181,783, claims 1-23 of US PAT. 5,949,473, claims 1-38 of US PAT. 5,929,896, claims 1-61 of US PAT. 5,844,596 and claims 1-30 of US PAT. 5,010,399. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are obvious version of the aforementioned patent claims using alternate languages and are directed to the same common subject matter, as follows: method and system for bi-directional transmission of data information using two-wire telephone network without passing the data information to the connected voice telephone equipments.

5. Claims 38-52, 58 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

6. Claim 58 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 38-52, 58 have not been further treated on the merits.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 33-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not have support for encoding part of the information in the second signal within two or more separate non-overlapping sub-bands within the second range of frequencies as is now claimed in new claim 33.

The specification does not have support for the second and third device transmitting information in the same common range of frequencies within the high band of frequencies without interference and encoding part of the information in the second signal within two or more separate non-overlapping sub-bands within the common range of frequencies as is now claimed in new claim 53. Furthermore, the specification does not disclose the lower band of frequencies are located above 30 Hz.

Dependent claims 34-57, 54-58 are also rejected for the same reason since they are dependent on a rejected base claim and contain the same problem(s).

9. **Any response to this action should be mailed to:**

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:


(703) 872-9314 for any facsimile communications (for Technology Center 2600 only).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is (703) 305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


W. F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC